



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,924	04/20/2001	Paul F. Struhsaker	WEST14-00028	2184

7590

06/22/2004

William A. Munck, Esq.
NOVAKOV DAVIS & MUNCK, P.C.
900 Three Galleria Tower
13155 Noel Road
Dallas, TX 75240

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 06/22/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary	Application No.		Applicant(s)	
	09/838,924		STRUTHSAKER	
	Examiner		Art Unit	
	Joy K Contee		2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment/Remarks

1. Applicant's response with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

The Double Patenting rejection under 35 USC 101, remains.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5,7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Uhlik et al. (Uhlik), U.S. Patent No. 6,600,914.

Regarding claim 1, Uhlik discloses in a multi-user FWA (fixed wireless access) communication system in which a plurality of subscriber stations are operable to communicate by way of radio links with network infrastructure to which a correspondent node is coupled, an improvement of apparatus for a selected subscriber station of the plurality of subscriber stations at which a call of selected call-type is selectably originated, said apparatus comprising:

a call establishment message generator coupled to receive an indication of initiation at the selected subscriber station of origination of the call, said call

Art Unit: 2686

establishment message generator for generating a call establishment message for communication to the network infrastructure to initiate call set-up procedures precursing a request to establish the call between the selected subscriber station and the correspondent node (see col. 1, lines 56-67, col. 2, lines 5-17, col. 5, lines 1-9 and see Figs. 1A and 2);

a response detector coupled to receive an indication of a network-infrastructure generated response to the call establishment message generated by said call establishment message generator, said response detector for detecting whether the response to the call establishment message indicates communication resources to be available to establish the call (col. 1, lines 56-62); and

a call set-up emulator coupled to said response detector, said call set-up emulator operable to emulate at the selected subscriber station normal call set-up operations thereat at least for a selected period responsive to detection by said response detector of unavailability of the communication resources to establish the priority call (col. 5, lines 1-10, lines 57-67 and col. 7, line 61 to col. 8, line 33 and see Figs. 2-3A).

Regarding claim 2, Uhlik discloses the apparatus of claim 1 wherein said call set-up emulator comprises a dial-tone generator, said dial-tone generator for generating an audio dial-tone at the selected subscriber station responsive to detection by said response detector of the unavailability of the communication resources (col. 2, lines 5-17).

Regarding claim 3, Uhlik discloses the apparatus of claim 2 wherein said

subscriber station comprises a telephonic station having an actuation keypad actuatable by a user to enter dialing digits associated with the correspondent node and wherein generation of the audio dial-tone by said dial-tone generator is terminated upon commencement of entry of the dialing digits (col. 9, lines 1-20 and see Figs. 1A and 2).

Regarding claim 4, Uhlik discloses the apparatus of claim 3 further comprising a dialing-digit signal generator coupled to receive indications of entry of the dialing digits at the actuation keypad said dialing-digit signal generator for generating a dialing-digit indication signal for communication to the network infrastructure pursuant to the request to establish the call between the subscriber station and the correspondent node (col. 8, lines 44-59 and see Figs. 1A and 2).

Regarding claim 5, Uhlik discloses the apparatus of claim 1 wherein the correspondent node comprises an assistance center having a dialing code formed of dialing digits associated with the assistance center, wherein the call of the selected call-type comprises a priority call, and wherein the dialing-digit signal generated by said dialing-digit signal generator is of values corresponding to the dialing code associated with the assistance center when the user actuates the actuation keypad to cause entry of the dialing digits forming the dialing code associated with the assistance center (col. 3, line 61 to col. 4, line 15).

Regarding claim 7, Uhlik discloses in the multi-user FWA communication system of claim 1, a further improvement of apparatus for the network infrastructure, said apparatus comprising; a call establishment message detector coupled to receive indications of receipt at the network infrastructure of the call establishment message;

Art Unit: 2686

and a response generator coupled to said call establishment message detector, said response generator for generating the response to the call establishment message (col. 5, lines 57-67).

Regarding claim 8, Uhlik discloses the apparatus of claim 7 further comprising a communication resource availability determiner operable responsive to detection of the call establishment message by said call establishment message detector, said communication resource availability determiner for determining whether communication resources are available to establish the call (col. 2, lines 5-26 and col. 7, lines 21-31).

Regarding claim 9, Uhlik discloses the apparatus of claim 8 wherein the network infrastructure is coupled to the correspondent node by way of a network backbone, and wherein said communication resource availability determiner determines both whether communication resources are available upon the network backbone to establish the call and whether communication resources are available upon the radio links to establish the call (col. 1, lines 26-36 and lines 56-67 and col. 2, lines 5-25).

Regarding claim 10, Uhlik discloses the apparatus of claim 8 wherein the subscriber station further sends a dialing digit indication signal to the network infrastructure and wherein said apparatus for the network infrastructure further comprises a dialing digit indication detector coupled to receive indications of receipt at the network infrastructure of the dialing digit indication signal (col. 5, lines 57-67, col. 7, lines 21-31 and col. 13, lines 13-26).

Regarding claim 11, Uhlik discloses the apparatus for the network infrastructure of claim 10 further comprising a resource reallocator coupled to said dialing digit

Art Unit: 2686

indication detector and to said resource availability determiner, said resource reallocator selectably operable to reallocate communication resources in the multi-user FWA communication system responsive to selected values contained in the dialing digit indication signal detected by said dialing digit indication detector (col. 9, lines 52-67 and col. 16, lines 51-56 and col. 20, lines 60-64).

Double Patenting

4. Claims 1-14 of this application conflict with claims 1-14 of Application Nos. **09/839,727** and **09/839,734**. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 09/839,727. This is a

Art Unit: 2686

provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of copending Application No. 09/839,734. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Allowable Subject Matter

7. Claims 6,12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: prior art of record fails to explicitly disclose the details in the dependent claims 6,12-14.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bilgic et al. , U.S. Patent No. 5,884,148, discloses a wireless local loop system and method.

Pentikainen et al., U.S. Patent No. 6,185,412, discloses a procedure and system for ensuring emergency communication in a wireless local loop environment.

Art Unit: 2686

Voit et al., U.S. Patent No. 5,659,605, discloses a method and apparatus for providing soft dial tone using office equipment designators.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

June 16, 2004


CHARLES APPIAH
PRIMARY EXAMINER